

AMENDMENTS TO THE DRAWINGS

The attached new formal drawings correct the margin objections as noted in the office  
action. These new formal drawings replace the drawings originally filed.

Attachment: New Formal Drawings with corrected margins

## **REMARKS**

Applicants express appreciation to the examiner for the interview granted to applicants' representative. At the interview proposed amendments to independent claims 1, 21, 23 and 30 were discussed as well as a new proposed independent claim, claim 35.

The examiner noted in the interview summary that the proposed amendments appear to advance the claims over the rejections of record, subject to the examiner's review of the formal amendment when received and updating the prior art search. Accordingly, as presented for reconsideration, the claims have been amended consistent with the matters presented and discussed at the interview.

Therefore, by this paper, claims 32-34 have been cancelled without prejudice, leaving claims 1-31, and new claim 35. Of those claims, claims 1 and 21 are method claims, which claim applicants' invention from a client-side perspective, whereas claim 23 is a method claim that claims applicants' method from a server-side perspective. Claims 11, 35, and 30 are computer program product claims which correspond to method claims 1, 21, and 23, respectively.

As presented herein for reconsideration, applicants' claimed method and computer program product are adapted for use in a network environment that includes a client that is network connectable over a wireless network to a server so that the client may transmit document-inclusion operations that are intended to be carried out by the server, but wherein the wireless network may have limited throughput such that data transfer for document-inclusion operations may be unduly slow or costly. Applicants' claimed method and computer program product are designed to reduce those instances when the document-inclusion operation transmitted to the server actually requires transmission of the document that is required by the server to complete the requested operation, thereby reducing instances of unduly slow or costly data transmission when performing such document-inclusion operations over a wireless network.

As claimed for example in independent claim 1, the method includes sending from the client over the wireless network a document-inclusion instruction to the server, the instruction including an identification of the document that does not depend on whether the document is actually identifiable at the server or not, and wherein the document-inclusion instruction that is

sent to the server does not include the document itself in the first instance. If the identified document is already stored at the server, the client's document-inclusion instruction is thus sufficient to permit the server to carry out the instruction so the client need take no further action in terms of sending the actual document to the server. On the other hand, if the identified document is not already stored at the server, then the client receives back from the server an indication that the document identified in the document-inclusion instruction is unavailable to the server. The client may then determine whether to send the identified document to the server over the wireless network or whether to simply wait and send the document later over a network that does not have the kind of limited throughput and bandwidth that the wireless network has.

Independent claim 23 claims the method in similar terms, except from a server-side perspective of the method. Claim 21 is directed to applicants' method and claims it from a client-side perspective similar to claim 1, except that independent claim 21 includes a functional step as a limitation (e.g. "a step for ensuring that a document-inclusion operation corresponding to the document-inclusion instruction is performed by the client if and only if the client is advised by the server that the identified document is not already stored at the server, so as to conserve the network bandwidth of the wireless network."). As noted at the interview, this functional step is clearly illustrated and described for example, along with the corresponding acts for that step, at figure 3 and the accompanying description of that figure in the specification.

In the office action the specification and drawings were objected to as not having the required margins (37CFR 1.84(g)). Applicants have therefore prepared and enclose herewith a complete substitute specification and a new set of formal drawings for replacement. Specifically, the information with respect to the firm's heading in the left margin of the specification and also the heading at the top of the drawings has been removed in accordance with the teleconference had with the examiner, thereby obviating the problems with the margins.

With respect to the rejections on art, each of the independent claims and a number of the dependent claims were rejected under 35 U.S.C. § 103(a) as obvious in view of published U.S. Application 2002/0010748 A1 ("Kobayashi"), and further in view of published U.S. Application 2002/0194307 A1 ("Anderson").<sup>1</sup>

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<sup>1</sup> The reference to Kobayashi qualifies as "prior" art, if at all, under 35 U.S.C. § 102(a). Anderson qualifies as "prior" art, if at all, under 35 U.S.C. § 102(e). Applicants therefore specifically reserve the right to challenge whether either or both references are in fact prior in time to applicants' invention. Therefore any argument or

Applicants' claimed method and computer program product are not anticipated nor made obvious by Kobayashi, either singly or in combination with any other reference of record. Kobayashi discloses a system and method for transmission or reception of e-mail with attached files. However, in the system and method of Kobayashi, before the mail terminal 100 (see Fig. 1) sends a request to the mail server 120 to attach a file to an e-mail, "the mail terminal 100 issues an ID acquisition request to the mail gateway 110 (S401). The mail gateway that receives the ID acquisition request issues a request for acquisition of a list of attached files to the mail server 120 (S402). The mail server that receives the request for acquisition of a list of attached files acquires a list of attached files included in the received mail from the mail sppl 122 and sends the list to the mail gateway 110 (S403). The mail gateway 110 that receives the list associates each of the attached files with an ID in accordance with the list *and sends the list of the attached IDs to the mail terminal 100 (S404).*" Page 6 ¶ 0097, emphasis added. Accordingly, "When the user selects attached files that the user wants to attach to the e-mail *from the list of IDs . . .* the mail gateway constructs e-mail including the selected attached files and the mail server transmits the constructed e-mail. . . ." Abstract, emphasis added.

Thus, contrary to applicants' claimed method, in Kobayashi's system and method, there is simply no need for the server to check to see whether a proposed attachment that is received in a message from the user's mail terminal is stored at the server and if not to identify the mail terminal that the attachment is not there, because clearly the proposed attachment for the e-mail has already been identified for the user in the list of IDs stored (in the ID acquisition unit 101) at the mail terminal. The user thus *only sends requests for attached documents that the user knows are already stored at the server.*

Applicants' invention is clearly different in this respect and indeed contrary to Kobayashi's method. As noted, applicants' claimed method requires that the document-inclusion instruction sent from the client "does not depend on whether the document is actually identifiable at the server or not." See claim 1. Accordingly, if the document that is to be attached is not stored at the server, then the client receives from the server "an indication that the document identified in the document-inclusion instruction is unavailable to the server so that the

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reference to either of these references is made simply assuming for purposes of argument that they are proper qualifying references.


client may then determine whether to send the document to the server. . . ." See claim 1. This simply does not occur in Kobayashi's system and method for the reason noted.

Accordingly, for at least this reason, applicants' claimed method and computer program product are neither anticipated nor made obvious by Kobayashi, either singly in combination with any other reference of record.<sup>2</sup> As noted in the Interview Summary, "the . . . amendments appear to advance the case over the rejection" of record, and thus favorable reconsideration and allowance of the claims is respectfully requested.

In the event of any further question that may be clarified by a teleconference, the Examiner is invited to initiate the same with the undersigned attorney of record.

Dated this 22<sup>nd</sup> day of June, 2005.

Respectfully submitted,

  
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<sup>2</sup> The secondary reference to Anderson in the office describes a system and method for remote document retrieval, specifically, a mobile print network that can be accessed by the user of a mobile device in order to identify and print documents at a network, which is remote from the user. In particular, Anderson describes at page 9, paragraph 0076 that when a properly formatted e-mail request is received (see figure 6a) by a document retriever, the document retriever then attempts to find the file that corresponds to the document that is to be printed. If the proper file cannot be found, then the document retriever proceeds to reply with an e-mail message, notifying the sender of the request that the file cannot be found. However, Anderson is improperly combinable with Kobayashi, for the same reason as noted above in reference to applicants' claimed method, namely, that Kobayashi never sends an e-mail with an identified document that is to be included with the e-mail *which the sender does not already know exists at the server*. Thus, Kobayashi and Anderson are inconsistent with one another and for that reason are not properly combinable. Even if that were not the case, and in any event, in view of the clear differences already noted to applicants' claimed invention as compared to Kobayashi, Kobayashi does not rise to the level of a *prima facie* case either singly or in combination with Anderson. In order to establish a *prima facie* case of obviousness, "the prior art references (or references when combined) must teach or suggest all claim limitations." MPEP §2143 (emphasis added).